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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,374	01/31/2000	Cesar Compadre	23533/119	3327

22428 7590 09/02/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/02/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Examiner

Applicant(s)

Group Art Unit

87

494374

COMPADRE et al

NEXLEY

16/6

27

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5/27/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 52707 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 52707 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 52, 82-84, 86, 87, 102, 103 and 107 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith - 5414124.

The rejection of record is maintained. The weight basis is undesignated, 50% of Benzal Konium chloride in total composition of solvent and Benzalkonium chlorite is  $16 + 84 = 100 + 50$ , (Table II) or  $50/50 = 33\%$  quaternary ammonium by weight; while the  $80\% \text{ Benzalkonium} + 48\% \text{ propylene glycol} + 512\% \text{ water} = 80 + 100 = 180$ ;  $80/180 =$  about 40% water actually is not required (col. 2, line 47 – 531 – and can be as high as 75%. Clearly 0-75% includes up to 5% (claims 83, 84). Claims 102, 103, 107 are dilutions of the concentrate immediately envisioned by one in the art of using concentrates.

Claims 53-61, 65-81, 85, 90-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al 5414124 in view of Gawurear et al 3787566.

The rejection of record is maintained.

The Smith/Gaureau are known charged quaternary compounds with a long history of germicidal use.

Claims 62, 89 and 104-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Merck.

The rejection of record is maintained.

Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al 5405604 in view of Vidra 4205061 and further in view of Merck.

The rejection of record is maintained.

Applicant's arguments filed on 5/27/03 have been fully considered but they are not persuasive. Applicant focuses on concentrations, and can not see how Smith anticipates. Applicant's concentrations as claimed are open to wide interpretation "greater than about". Smith is greater than, and about, as the office reads the claims. See comment at continued rejection.

Applicants' arguments over the obviousness rejection, again applicants issues is with concentration; but the smith formulations are to concentrates, thus clearly dilatable on it's face applicant's arguments, failure of obtaining expectation for success, for substituting pyridinium chloride for a quaternary ammonium, are not persuasive; the compounds and formulation are known to be disinfectants and manipulable by one of low skill in the disinfectant arts to obtain desired concentrations of desired disinfectant actives, based on availability and cost. Argued addition of terpenes as precluding substitution is also not persuasive – applicant uses open language and nothing preclude added ingredients from either references.

It is not necessary that the references actually suggest, expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCA 1968).

It is well settled that it is a matter of obviousness for one of ordinary skill in the art to combine two or more materials when each is taught by the prior art to be useful for the same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). It is not necessary that each of the known ingredients be equivalent with respect to degree of effectiveness.

Applicant's arguments with respect to Merck's inclusion in the obviousness rejections are seen as arguing for unclaimed advantageous parameters. However, we see applicant's claims are also to the disadvantageous glycerol, and, further the argued for advantages of the declaration are limited to CPC – The claims are not. The teachings of the references would have reasonably suggested to one of ordinary skill in this art that such matters are result effective variables and that desired workable or optimum ratio and amount ranges could be arrived at by routine experimentation. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). "[I]t is not inventive to discover the optimum or workable ranges by routine experimentation").

Examiner appreciated formulae correction.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



**NEIL S. LEVY**  
**PRIMARY EXAMINER**

Levy/LR  
August 20, 2003